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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,745	01/23/2004	David F. MacNeil	301700-000066	7637
43138	7590	08/06/2004	EXAMINER	
DASPIN & AUMENT, LLP 210 WEST 22ND STREET, SUITE 102 OAK BROOK, IL 60523			GREEN, BRIAN	
			ART UNIT	PAPER NUMBER

3611

DATE MAILED: 08/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/763,745

Applicant(s)

MACNEIL, DAVID F.

Examiner

Brian K. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 7-12 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 7-12 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

This application is claiming the benefit of a prior filed nonprovisional application under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required.

Serial no. 10/151,361 was patented before the applicant filed the present application.

Therefore, the applications were not copending. The applicant should consider including application 10/315,424 for copendency purposes.

Claim Rejections - 35 USC § 112

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 is indefinite since it is not clear whether the two elongate channels defined include the channel defined in claim 15 or are two additional channels.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11,15-18,2,3,12,4,7,8,9, and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,10,12,13,3,5,6,8, and 9 of U.S. Patent No. 6,760,986. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1,10,12,13,3,5,6,8, and 9 disclose a frame having a channel, an elastomeric gasket, first and second compression ribs, a raised rim, a V-shaped rib, stepped holes in the frame, and the gasket formed from a rubber with an ultraviolet inhibitor.

Claims 11,15-18,2,3,12,4,7,8,9, and 10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,2,3-6, and 8-10 of copending Application No. 10/315,424. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1,2,3-6, and 8-10 disclose a frame having a channel, an elastomeric gasket, first and second compression ribs, a raised rim, a V-shaped rib, stepped holes in the frame, and the gasket formed from a rubber with an ultraviolet inhibitor.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11,15-17,2-4, and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Leopold et al. (U.S. Patent No. 1,664,302).

Leopold et al. shows in figures 1-3 a transparent frame (2), a channel (the recess within the flange 3), a plurality of holes (6), and a rubber gasket (10) within the channel. The gasket (10) inherently includes a color and is therefore considered to be a “colored gasket”. The color of the gasket is visible through the frame (2). In regard to claim 11, as broadly defined, the gasket of Leopold et al. is capable of being “adhered” to the channel. In regard to claim 16, Leopold et al. shows a compression rib (the projection extending in a horizontal direction in figures 3 and 4 or the generally vertically extending rib adjacent to the lead line for numeral 10). In regard to claim 17, Leopold et al. shows in figures 1-4 that the gasket includes four compression ribs (the projection extending in a horizontal direction in figures 3 and 4), i.e. ribs on the left and right side of the license plate and ribs on the top and bottom of the license plate. In regard to claims 2 and 9, as broadly defined, the rib on the left side of the license plate is considered to be in a plane “inward” relative to an inwardmost surface of the rib on the right side of the license plate. In regard to claim 3, Leopold et al. shows in figures 2-4 that the gasket has a raised rim (the projection generally vertically in figures 3 and 4). In regard to claim 4, the generally vertical rib (adjacent the lead line for numeral 10 in figure 3) is generally V-shaped. In regard to claim 7, the holes (6) are stepped, see figure 2. In regard to claim 8, the rib surrounds a majority of the

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frame and a portion of the bottom is open (the openings 6 in the bottom of the frame form an opening).

Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Dutt (U.S. Patent No. 4,308,965).

Dutt shows in figures 1-5 a frame (10), a channel (one of the channels which receive portions 40 or 54 or 56 or 58), an elastomeric gasket (16 or 20 or 50), and the gasket is strongly adhered to an inside surface of the channel, see column 4, lines 35-37.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzalez (U.S. Patent No. 5,255,166) in view of Means (U.S. Patent No. 4,813,167).

Gonzalez shows in figures 1-6 a license plate cover comprising a transparent frame (18) having an elongate annular channel (32), an annular decorative insert (20), and a sealing device (40). Gonzalez does not disclose the idea of making the sealing device (40) in the form of an elastomeric gasket. Means shows in figure 3 and 5 the idea of making a sealing device (90, 90") in the form of an elastomeric gasket, see column 4, lines 64-68. In view of the teachings of

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Means it would have been obvious to one in the art to modify Gonzalez by making the sealing device in the form of an elastomeric gasket since this would allow the channel to be sealed in a better and easier manner. Gonzalez shows a plurality of holes (37,38,37a,38a) for receiving fasteners. In regard to claim 10, Gonzalez shows in figures 4-6 a first channel which is considered to be the horizontal channel in the top of the frame and the second channel is considered to be the channel in the bottom of the frame. In regard to claim 11, the gasket inherently includes a color and can be seen through the frame.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzalez (U.S. Patent No. 5,255,166) in view of Means (U.S. Patent No. 4,813,167) as applied to claim 11 above and further in view of the applicant's admitted prior art on page 8, paragraph 0021.

Gonzalez in view of Means does not disclose whether the gasket includes an ultraviolet inhibitor. The applicant discloses on page 8, paragraph 0021 that the use of gaskets with ultraviolet inhibitors are known in the art. In view of the applicant's admitted prior art it would have been obvious to one in the art to modify Gonzalez by attaching an ultraviolet inhibitor to the gasket since this would create a more durable and longer lasting gasket.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leopold et al. (U.S. Patent No. 1,664,302) in view of the applicant's admitted prior art on page 8, paragraph 0021.

Leopold et al. does not disclose whether the gasket includes an ultraviolet inhibitor. The applicant discloses on page 8, paragraph 0021 that the use of gaskets with ultraviolet inhibitors

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are known in the art. In view of the applicant's admitted prior art it would have been obvious to one in the art to modify Leopold et al. by attaching an ultraviolet inhibitor to the gasket since this would create a more durable and longer lasting gasket.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leopold et al. (U.S. Patent No. 1,664,302) in view of Yesbick (U.S. Patent No. 5,787,625).

Leopold et al. discloses the applicant's basic inventive concept except for adhering the gasket to the channel. Yesbick shows in figure 6 a gasket (26) that is adhered to a frame plate (11), see column 5, lines 3-7. In view of the teachings of Yesbick it would have been obvious to one in the art to modify Leopold et al. by adhering the gasket within the channel since this would allow the gasket to be held in a desired location, i.e. it would allow the holder to be assembled in a faster and easier manner and would help to insure the gasket is held in the proper position for proper sealing.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Huff, Jr. discloses the use of a frame that includes a seal. Krokos et al. discloses the use of a license plate cover with stepped openings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
Aug. 2, 2004